UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,603	02/22/2002	Masakatsu Kiwada	325772028100	8470

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EXAMINER
MIRZA, ADNAN M

ART UNIT	PAPER NUMBER
2145	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/079,603	KIWADA ET AL.
	Examiner	Art Unit	
	Adnan M. Mirza	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 July 2006*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32, 34, 36 and 38* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32, 34, 36, 38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-32, 34, 36, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Friday (U.S. 6,631,453) and Kenworthy (U.S, 6,317,837).

As per claims 1,13,17,22,28,36 Friday disclosed an image processing method for forming images

on an image forming device based on a file stored in an image forming data transmission device

using a portable terminal, said image forming data transmission device connected. to a first

internal network constructed, inside a first firewall, said image forming device connected to a

second internal network constructed inside a second firewall, ,and a file server connected to an

external network constructed on the outside of said first firewall and said second firewall,

comprising: said portable terminal establishing a connection with said image forming data

transmission device via said second internal network, said second firewall, said external network,

said first firewall and said first internal network using a protocol (col. 6, lines 14-41); said image

forming data transmission device receiving said image forming request transmitted by said

portable terminal and preparing an image forming data for said file according to said image

forming request; said image forming data transmission device establishing a connection with said

file server via said first internal network, said first firewall, and said external network using a

protocol, which allows connections only from the internal network to the external network at

said first firewall (col. 5, lines 42-66); said image forming data transmission device uploading

said prepared image forming data to said file server; said image forming device establishing a

connection with said file server via said second internal network, said second firewall, and said

external network using a protocol, which allows connections only from the second internal

network to the external network at said second firewall: said image forming device downloading

said image forming data from said file server; and said image forming device forming said image

based on said downloaded image forming data (col. 17, lines 48-67 & col. 18, lines 1-21).

However Friday did not disclose in detail "which allows bi-directional connections between the

first and second internal networks and the external network at said first firewall and said second

firewall; said portable terminal transmitting an image forming request for said file stored in said

image forming data transmission device to said image forming data transmission device".

In the same field of endeavor Kenworthy disclosed, "In this way, the NADFW-MS 111 is able to

screen a data packet based on particular network node from which the data packet was sent. This

mechanism provides the NADFW-MS 111 with multi-directional access control (col. 8, lines 11-

15).

It would have been obvious to one having ordinary skill in the art at the time of the invention

was made to have incorporate, "In this way, the NADFW-MS 111 is able to screen a data packet

based on particular network node from which the data packet was sent. This mechanism provides

the NADFW-MS 111 with multi-directional access control" as taught by Kenworthy in the

method of Friday to provide data secure environment for business to business computing.

3.   As per claims 2,8 Friday-Kenworthy disclosed comprising said image forming data

transmission device transmitting a storage location data indicating where said uploaded image

forming data is stored on said file server to said portable terminal; said portable terminal

receiving said storage location data which said image forming data transmission device

transmitted (Friday, col. 4, lines 29-39); said portable terminal displaying said received storage

location data; and said image forming device receiving an entry of said storage location data;

wherein said image forming device downloads said image forming data from the storage location

on said file server based on said storage location data (col. 5, lines 50-65).

4.   As per claims 3,9,33,35,37,39 Friday-Kenworthy disclosed comprising said image

forming data transmission device transmitting a storage location data indicating where said

image forming data is stored on said file server to said portable terminal; said portable terminal

receiving said storage location data which said image forming data transmission device

transmitted; said portable terminal displays said storage location data; said image forming device

receives an entry of said storage location data; wherein said image forming device downloads

said image forming data from the storage location on said file server based on said storage

location data (Friday, col. 18, lines 51-64).

5.   As per claims 4,10,18,23,26,29 Friday-Kenworthy disclosed further comprising said file

server transmitting a storage location data indicating where said image forming data uploaded by

said image forming data transmission device is stored on said file server to said portable

terminal; said portable terminal receiving said storage location data which said file server

transmitted (Friday, col. 18, lines 38-49); said portable terminal displays said storage location

data; and image forming device receiving an entry of said storage location data; wherein said

image forming device downloads said image forming data from the storage location on said file

server based on said storage location data (Friday, col. 18, lines 51-64).

6.   As per claims 5,11,19,30 Friday-Kenworthy disclosed further comprising wherein said

file server transmitting a storage location data indicating where said image forming data

uploaded by said image forming data transmission device is stored on said file server to said

portable 10 terminal; portable terminal receiving said storage location data which said file server

transmitted (Friday, col. 18, lines 38-49); said portable terminal transferring, said storage

location data to said image forming device via said second internal network or a local

communication circuit; said image forming device receiving said storage location data

transferred by said portable terminal; wherein said image forming device loads said image

forming data from the storage location on said file server based on said storage location data

(Friday, col. 18, lines 51-64).

7.   As per claims 6,12,14,16,20,24,27,31 Friday-Kenworthy disclosed wherein said image forming device is a printer and said image forming data is a printing job (Kenworthy, col. 3, lines 19-21).

8.   As per claims 7,15,21,25,32,34,38 Friday-Kenworthy disclosed an image processing method for forming an image on an image forming device based on a file stored in an image forming data transmission device using a portable terminal, said image forming data transmission device connected to a first internal network constructed inside a first firewall, said image forming device connected to a second internal network constructed inside a second firewall, and a file server connected to an external network constructed on the outside of said first firewall and said second firewall, comprising: said portable terminal establishing a connection with said image forming data transmission device via a public network, a public network authenticating server connected to said first internal network, and said first internal network; said portable terminal transmitting an image forming request for said file stored in: said image forming data transmission device to said image forming data transmission device (Kenworthy, col. 8, lines 11-15); image forming data transmission device receives said image forming request transmitted by said portable terminal and prepares an image forming data for said file according to said image forming request; said image forming data transmission device establishing a connection with said file server via said first internal network, said first firewall, and said external network using a protocol, which is allows connections only from the first internal network to the external network at said first firewall; said image forming data transmission device uploads said prepared image forming data to said file server; said image

forming device establishing a connection with said file server via said second internal network,

said second firewall, and said external network using a protocol, which allows connections only

from the internal network to the external network at said second firewall; said image forming

device downloading said image forming data from said file server; and said image forming

device forming said image based on said downloaded image forming data (Friday, col. 17, lines

48-67 & col. 18, lines 1-21).

Response to Arguments

Applicant's arguments filed 07/19/2006 have been fully considered but they are not persuasive.

Response to applicant's arguments is as follows. During the telephone interview on June 1,2006,

with applicant's representative examiner point out the claim language and its interpretation.

Examiner recommended the applicant to amend the claims. As of right now the language of the

claims does not direct to the print job for a image forming device.

A.   Applicant argued that there is not motivation to combine references and the combination

is improper.

In response to applicant's argument that there is no suggestion to combine the references, the

examiner recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Kenworthy taught in the method of Friday provide a firewall to have secure

communication between the data component.

B.   Applicant argued that prior art did not disclose, "Portable terminal establishing a

connection with said image forming data transmission device via said second internal network

(col. 2, lines 54-56)".

As to applicant's argument Friday disclosed, "establishing an active data connection to the first

computer. A passive data connection is established for the second computer" (col. 2, lines 54-

56).

C.   Applicant argued that prior art did not disclose, "which allows bi-directional connections

between the internal network and the external network at said first firewall and said second

firewall".

As to applicant's argument Kenworthy disclosed, "In this way, the NADFW-MS 111 is able to

screen a data packet based on particular network node from which the data packet was sent. This

mechanism provides the NADFW-MS 111 with multi-directional access control" (col. 8, lines

11-15).

D.   Applicant argued that prior art did not disclose, "establishing a connection with said

image forming data transmission device via a public network, a public network authenticating

server connected to said first internal network".

As to applicant's argument Friday disclosed, "An external system such as Internet or another

external system passes a request for information through a router. The router receives the request

and passes it into firewall. The firewall has port which is coupled to the router. Data received

through the port is sent to an external connector which passes the request to an inspection filter

using the process or code extracted from a secure storage device (col. 17, liens 47-57). Is the

request deemed to be appropriate by the inspection filter, the request is passed through an

internal connection and is considered validated request (col. 18, lines 3-5)".

Conclusion

9.   Any inquiry concerning this communication or earlier communication from the examiner

should be directed to Adnan Mirza whose telephone number is (571)-272-3885.

10.   The examiner can normally be reached on Monday to Friday during normal business

hours. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jason Cardone can be reached on (571)-272-3933. The fax for this group is (703)-

746-7239. The fax phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

11.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for un published

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at (866)-217-9197 (toll-free).

AM

Adnan Mirza

Examiner

JASON CARDONE
SUPERVISORY PATENT EXAMINER